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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BUDD, MARK OSBORNE

ART UNIT PAPER NUMBER

2834

DATE MAILED: 01/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

815 250

Applicant(s)

Scott et al

Examiner

M. Budd

Group Art Unit

2834

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 11-25-02

☒ This action is FINAL.

- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-9, 18, 23, 54 and 63-85 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-9, 18, 23, 54 and 63-85 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

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Claims 64-72 and 75-83 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are vague and indefinite in that they conflict or contradict parent claims 1 or 54. Claims 1 and 54 specify operation in an impedance mode wherein these claims specify operation in a Doppler, echo or voltage mode. Thus, one cannot determine the metes and bounds of these claims.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-9, 18, 23, 54, 63, 73, 74, 84 & 85 rejected under 35 U.S.C. 102() as being by Asano or Chatigny.

Each reference teaches a ceramic piezo electric sensor having a plurality of elements (Chatigny fig 13; Asano figs 3 and 6-8), impedance inherently varies when a piezo element is loaded, also impedance variations are detected (see both abstracts) and a process or is coupled to the output of the piezo array (Chatigny fig 11. Asano fig 3, 14 and 35). With respect to "said sensor operating in an impedance mode", "voltage mode", "Doppler mode" "echo mode" "the output data representing ---" are functional and add no structure to the combination. Courts have found that claims directed to apparatus must be distinguished from the prior art in terms of

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structure rather than function. In re Danly, 23 F.2d 844, 847. "Apparatus claims cover what a device is, not what a device does." Hewlett-Packard Co v Bausch & Lomb Inc., 909 F. 2d 1464, 1469. Thus, the above noted phrases do not patentably distinguish from the cited art.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims rejected under 35 U.S.C. 103(a) as being unpatentable over Asano or Chatigny in view of Wright or Mine.

Asano and Chatigny teach a piezo electric detector that outputs data relative to a finger by monitoring impedance changes. They do not detect blood flow, bone density etc or explicitly operate in a Doppler or echo mode. However, use of detectors to provide the various output data and operating in the specific modes are known as taught by Mine or Wright. To select what data to evaluate or which mode of operation from among known sets of data and modes for Asano or Chatigny would have been obvious to one of ordinary skill in the art. Conversely, Mine and Wright teach systems for providing the desired data except for the specific detector transducer. However, each of Asano and Chatigny teach using an array of piezo elements to detect various finger parameters. Thus to select the specific, known detector of Asano or Chatigny (due to low power requirements, mechanical strength, ease of manufacture, etc) for use in the systems of either Mine or Wright would have been obvious to one of ordinary skill in the art.

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Further cited of interest are Muramatsu, Pant, Kolesar, Wise, Oyama, Hosda, Jarvis and Dario.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

M BUDD/pj

01/14/03


MARK O. BUDD
PRIMARY EXAMINER
ART UNIT 212